

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

MAILED

MAY 31 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARSTEN ROHR, KEITH W.J. BARNHAM, NICHOLAS EKINS-DAUKES,
JAMES P. CONNOLLY, IAN M. BALLARD and MASSIMO MAZZER

Appeal No. 2005-0619
Application No. 09/955,297

ON BRIEF

Before GARRIS, WARREN and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Because the above identified application is not yet in condition for disposition of the outstanding appeal, we hereby remand this application to the jurisdiction of the examiner for action consistent with the following comments.¹

¹Due to the need for this remand, the oral hearing which had been scheduled for May 18, 2005 was cancelled via a communication on May 17, 2005 to the attorney of record by Program and Resource Administrator Craig R. Feinberg.

Appeal No. 2005-0619
Application No. 09/955,297

In response to the examiner's answer mailed September 21, 2004, a reply brief was filed on November 22, 2004. According to the appellants, this reply brief was submitted in order to address "a portion of the multiplicity of errors replete in the Examiner's Answer" (reply brief, page 2). These alleged errors are summarized on page 2 of the reply brief as follows:

Among the errors addressed are: (1) strain is not the same as stress; (2) Appellants' independent claim requires "substantially no shear force" and not substantially no shear strain; (3) a zero strain configuration as taught in Ekins-Daukes I is not the same as a substantially zero stress combination; and (4) the Examiner has clearly ignored paragraph 12 of Dr. Anderson's Declaration.

In addition to arguments regarding these alleged errors, the reply brief includes an attached exhibit (i.e., "**EXHIBIT 1**") in support of the aforementioned arguments.

The examiner responded to this reply brief (via a communication mailed December 8, 2004) by stating that "[t]he reply brief filed November 22, 2004 . . . has been entered and considered." However, this response does not provide the Board with adequate assistance in assessing the merits of the reply brief arguments. Moreover, the examiner's response does not explicitly address whether the aforementioned exhibit also has been entered and considered by the examiner. Finally, we observe that the reply brief arguments include a discussion of the

Appeal No. 2005-0619
Application No. 09/955,297

declaration of record by Dr. Anderson and that the examiner's answer does not contain an analysis of the portion of this declaration (i.e., paragraph 12 thereof) focused upon in the reply brief.

Under these circumstances, the examiner must respond to this remand by clarifying whether the above noted exhibit has been entered and considered along with the reply brief attached thereto. Further, the examiner must reconsider each of the reply brief arguments and, if these arguments are regarded as unpersuasive, must provide the application file record with a complete explanation of why these arguments are thought to be not convincing. We emphasize that this explanation must include a rebuttal of the appellants' arguments concerning the Anderson declaration of record as well as the reply brief exhibit (if entered).

Any response to this remand by the examiner and subsequently by the appellants must comply with the current regulations concerning ex parte appeals at 37 CFR § 41.30 through § 41.54 which became effective September 13, 2004.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made

Appeal No. 2005-0619
Application No. 09/955,297

for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This application, by virtue of its "special" status, requires an immediate action; see the Manual of Patenting Examining Procedure, (MPEP) § 708.01(D) (8th Ed., Rev. 2, May 2004). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED



BRADLEY R. GARRIS)
Administrative Patent Judge)



CHARLES F. WARREN)
Administrative Patent Judge)



JEFFREY T. SMITH)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

BRG:hh

Appeal No. 2005-0619
Application No. 09/955,297

NIXON & VANDERHYE, P.C.
1100 N. GLEBE RD.
8TH FLOOR
ARLINGTON, VA 22201-4714